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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,082	09/24/2001	Wei-Sing Chu	2313-113	1159

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EXAMINER

SPIEGLER, ALEXANDER H

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action**Application No.**

09/869,082

Applicant(s)

CHU, WEI-SING

Examiner

Alexander H. Spiegler

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 20-26.

Claim(s) withdrawn from consideration: 27-36.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicant has added Claim 43, which recites, "A coverslip for a microscope slide wherein a portion of said coverslip is concave thereby enclosing a constant volume when placed onto a microscope slide". This new claim requires that there be a "constant" volume. The previous claims did not recite a "constant" volume. Accordingly, this newly added claim would require new search and consideration for a concave coverslip enclosing a "constant" volume.

Continuation of 5. does NOT place the application in condition for allowance in view of the non-entry of the amendment filed on April 8, 2004, and in view of the reasons below and those of record.

Applicant argues "known" is defined in the specification, however the passages which Applicant has referred do not teach a specific definition as to what is encompassed by the recitation of "known". It is not clear as to whether "known" means that the skilled artisan "knows" the volume as soon as the reagent is placed into the microscope slide, right before an assay occurs on the slide, or after an assay occurs on the slide, etc. Furthermore, there is no set definition or parameter as far as to what constitutes how exact or precise the volume must be "known". For example, when one deposits "about" one drop onto a slide, they "know" there is "about" one drop on the slide. Even if the skilled artisan uses a slightly larger volume than the volume between the concave surface of the cover, they "know" they have placed a larger volume onto the slide, and moreover, they "know" that a small amount may spill out.

Applicant's argument that a skilled artisan would not know how much volume is contained in about one drop is not persuasive for several reasons. First, the claim recites only that a "known" volume is enclosed, and not "how much" volume is "known". Simple awareness of the presence of a drop of reagent does amount to knowledge of the volume of that drop when placed within a coverslip. For example, when placing about one drop on the slide of Atwood, which is then enclosed by a concave coverslip, the skilled artisan would "know" that the volume cannot exceed a certain volume by virtue of the coverslip dimensions. Furthermore, as previously cited in the last office action, Atwood cites several passages indicating a "known" volume.

Applicant argues page 28, lines 6-20 teach methods of achieving a known volume. This is not persuasive since these method steps are not recited in the claims.

Applicant argues by virtue of Atwood's compliant cover, the volume will not be "known". This is not persuasive since, for example, there is no set definition of how precise one must know what the volume is. Even assuming the concavity of the cover changes, these changes are "known" by skilled artisans given the teachings of Atwood, and therefore, the volume will be known. (see last office action for teachings of Atwood).

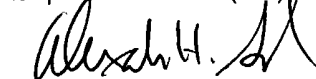
Applicant's arguments with respect to using a pipet is not persuasive. First, molecular biologist routinely use pipets to deliver reagents in accurate amounts; this is acknowledged on page 33, line 2, where the specification states, "pipetting of small, accurate amounts of reagents". Second, there is no guarantee or teaching of an unexpected result that the delivery mechanism used by Applicant provides absolute delivery, wherein no reagent is spilled out. Furthermore, even assuming some reagent will spill out, the skilled artisan "knows" that some will spill out, and the volume enclosed within the coverslip will still be "known".

For these reasons and those of record, the rejections are maintained.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander H. Spiegler whose telephone number is (703) 305-0806 or (571) 272-0788 after January 22, 2004. The examiner can normally be reached on Monday through Friday, 7:00 AM to 3:30 PM.

If attempts to reach the examiner are unsuccessful, the primary examiner in charge of the prosecution of this case, Carla Myers, can be reached at (703) 308-2199 or at (571) 272-0747 after January 13, 2004. If attempts to reach Carla Myers are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119 or at (571) 272-0782 after January 22, 2004. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306. Applicant is also invited to contact the TC 1600 Customer Service Hotline at (703) 308-0198.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Alexander H. Spiegler
April 16, 2004



GARY BENZION, PH.D.
SUPERVISORY PATENT EXAMINER
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4/16/04